



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SW

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/929,425	08/13/2001	Stephen F. Gass	SDT 311	9671

27630 7590 12/16/2004
SD3, LLC
22409 S.W. NEWLAND ROAD
WILSONVILLE, OR 97070

EXAMINER

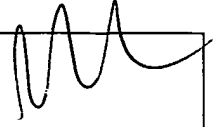
ASHLEY, BOYER DOLINGER

ART UNIT PAPER NUMBER

3724

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/929,425	Applicant(s) GASS ET AL. 	
	Examiner Boyer D. Ashley	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,8,24,25,27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7,9,17-23 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/18/04; 4/17/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>1449's - 2/9/04</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/12/04 has been entered, wherein claims 17-28 were added and 10-16 were canceled. Claims 1-9 and 17-28 are currently pending with claims 5-6 and 8 remaining withdrawn as drawn to non-election. It should be noted that claim 21 is currently improperly depended upon itself, for the purposes of this office action claim 21 is being considered depended upon claim 20. Applicant is requested to correct this in subsequent responses.

2. Newly submitted claims 24-25 and 27-28 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

3. Claims 24 and 27 corresponds the original group B, while claims 25 and 28 corresponds to a new group. For example Group D, wherein the combinations of Groups A-D related to as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, the pawl mount of Group II could be used without the piston/cylinder device of Group D; conversely, the piston/cylinder device of Group D could be used without the pawl mount of Group II. See MPEP § 806.05(d).

Art Unit: 3724

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-25 and 27-28 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "translational" cutter movement of claim 7 in combination of a miter saw in claim 26 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

It appears that Figures 1-3 do not show a miter saw with translational movement.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of

Art Unit: 3724

the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

SPECIAL CIRCUMSTANCES OF THIS APPLICATION:

Even if a copending application is listed on this instant application or other copending applications or patents and the material information is technically of record in one or more parent or copending applications, the unusually large number of applicant's cases in varying stages of the examination process might result in one or more parent applications not being readily available for review, or material information of record not being readily apparent. Moreover, applications, which may not have any direct relationship, as continuing applications, to other copending applications by the same assignee may not be readily apparent due to the unusually large number of applicant's cases.

Applicant should point out such material information to the examiner of the instant application if the criteria for materiality applies, and if the examination record provides applicant reason to believe such information has not been considered by the examiner. This should include a listing of all related cases whether previously filed, recently filed, currently being filed, or patented.

If, to the best of applicant's knowledge, applicant has no previous patent or copending application, which would meet the definition of "material," applicant is requested to make a statement of that fact of record.

Any parent application labeled as a CIP or Divisional is assumed to claim a patentably distinct invention from the claims of this application and therefore the issue of double patenting has not been considered and the rights to priority are limited to the common disclosed subject matter unless it is brought to the examiners attention that some claims are not distinct.

37 CFR 1.56. Duty to disclose information material to patentability.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of patentability.

Art Unit: 3724

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7, 9, and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In light of specification and drawings is not clear how the radial arm saw in Figure 3 and claimed in claim 7 includes a miter saw as in claim 26. Is claim 26 have improper dependence? If so, a correction to the dependence should obviate this rejection and the objection to the drawings.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

Art Unit: 3724

patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-4, 7, 9, 17-19, 23, and 26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7-8 of U.S. Patent No. 6,826,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter, that is, the claims of U.S. Patent 6,826,988 anticipate the claims of 1-4, 7, 9, and 17-25 of the instant application. For example, claim 1 of the instant application requires a woodworking machine, *inter-alia*, with a detection system adapted to detect contact between a person and the cutting tool; and a reaction system adapted to stop motion of the cutting tool into the cutting zone upon detect of contact between the a person and the cutting tool. However, claim 7 of U.S. Patent 6,826,988 recites a woodworking machine (miter saw), *inter-alia*, with a detection system configured to detect accidental contact between a person and the blade; and a reaction system configured to stop the movement of the cutting tool in response to the detection system.

9. Claims 1-2, 4, 17-19, and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 20, and 27 of copending Application No. 10/051,782 in view of Yoneda. Copending application '782 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user and the blade instead of

Art Unit: 3724

contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

10. Claims 1-2, 4, 7, 9, 17-23, and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-30, and 35-40 of copending Application No. 09/676,190 in view of Yoneda. Copending application '782 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user and the blade instead of contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

Art Unit: 3724

11. Claims 1-2, 4, 7, 9, 17-23, and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 12-14, and 19-20 of copending Application No. 10/052,806 in view of Yoneda. Copending application '782 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user and the blade instead of contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

12. Claims 1-2, 4, 17-19, and 23 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, and 8-9 of copending Application No. 10/643,296. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter, that is, the claims of copending application '296 anticipate the claims of 1-4, 17-19 and 23-25 of the instant application. For example, claim 1 of the instant application requires a woodworking machine, *inter-alia*, with a detection system adapted to detect contact between a person and the cutting tool; and a reaction system adapted to stop motion of

Art Unit: 3724

the cutting tool into the cutting zone upon detect of contact between the a person and the cutting tool. However, claims 1 and 8-9 of '296 recites a miter saw, *inter-alia*, with a detection system configured to detect accidental contact between a person and the blade; and a reaction system configured to stop the movement of the cutting tool in response to the detection system.

13. Claims 1-2, 4, 7, 9, and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-12, 14-19 and 8-9 of copending Application No. 09/955,418. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in claim terminology but encompass the same subject matter, that is, the claims of copending application '418 anticipate the claims of 1-2, 4, 7, 9, and 17 of the instant application. For example, claim 1 of the instant application requires a woodworking machine, *inter-alia*, with a detection system adapted to detect contact between a person and the cutting tool; and a reaction system adapted to stop motion of the cutting tool into the cutting zone upon detect of contact between the a person and the cutting tool. However, the claims of '418 recite a up-cut chop, *inter-alia*, with a detection system configured to detect accidental contact between a person and the blade; and a reaction system configured to stop the movement of the cutting tool in response to the detection system by reversing the movement of the tool.

14. Claims 1-2, 4, 7, 9, 17-23, and 26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-24 of copending Application No. 10/052,273 in view of Yoneda. Copending

Art Unit: 3724

application '273 discloses the invention substantially as claimed except for the detection system only detects a dangerous condition between the user and the blade instead of contact between the user and the blade. However, Yoneda discloses that it is old and well known in the art to use detection systems with cutting tools that detect contact between a user and a blade for the purpose of prevent injury to the user while prevent premature stopping of the tool. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to a detection system that senses contact instead of dangerous conditions in order to prevent injury to the user and to prevent premature stopping of the tool.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4, 7, 9, 17, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaines in view of Lokey or Friemann et al. for the reasons as set forth in paragraph 11 of action dated 7/12/04 and included here.

As to claim 17, the device of modified device Gaines is capable of resting on a generally horizontal surface.

17. Claims 1, 17, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al., U.S. Patent 5,791,224, or Brundage et al., U.S. Patent

Art Unit: 3724

4,934,233, in view of Gaines or Terauchi, U.S. Patent 4,512,224, and Lokey or Friemann et al.

Suzuki et al. and Brundage et al. discloses the invention substantially as claimed except for detecting contact between a person and blade, a reaction system to limit/stop movement of the blade into the work zone upon detection of contact between the user and the blade. However, both Gaines and Terauchi discloses stopping movement of a cutting tool into the cutting zone upon detecting of unsafe or damaging situation. Lokey discloses that it is old and well known in the art to stop the motion of a circular cutting tool when a dangerous condition is sensed between the user and the blade for the purpose of preventing injury to the user. Friemann et al. discloses that it is old and well known in the art to stop the motion of a cutting tool upon detection of contact between a user and the blade for preventing injury to the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to stop the movement of the blades of Suzuki et al. and Brundage et al. into the work zone upon detecting a dangerous conditions, such as contact between the user and the blade, in order to prevent further injury to the user.

Response to Arguments

18. Applicant's arguments filed 10/12/04 have been fully considered but they are not persuasive.

Applicant contends that the double patenting rejections are improper for the following reasons: 1) the co-pending claims address later-developed species claims, that is, the claims of the later filed applications are more narrow than the claims of the

instant application. Therefore, the claims in the instant application are not obvious in light of the copending applications because the invention did not exist at the time of the invention of the instant claims was made or at the time. In this case, the applicant could not have filed the claims in the same application and the inventive entities are different; 2) applicant further states that claims in the instant application may be encompasses in the copending application claims but that in of itself is insufficient to support a double patenting rejection because the issues of claim dominance and double patenting must not be confused. MPEP 804; and 3) applicant also contends that two-way obviousness analysis should be applied for these rejections because the applicant could not have filed the claims in a single application.

Although, the examiner sympathizes with the applicant regarding the double patenting rejections, the examiner can find no support for applicant's arguments in the MPEP.

It should be noted that applicant appears to be confusing the different types of double patenting as well as the requirements for obviousness type double patenting with regard to 35 USC 103. The fact that the improvement was later developed and sought does not prevent double patenting. There is no requirement that double patenting rejection must to be limited to applications that are filed concurrently nor is there any requirement limiting double patenting based upon filing dates of the application, that is, it does not matter which one is filed first. The fact that the improvement was not known to the applicant at the time of invention/filing of the earlier filed application does not preclude double patenting. The facts are, that the instant

Art Unit: 3724

application has broad claims, which are readable on by the subsequent applications. If the instant application claims were issued without a terminal disclaimer the potential problem of dual ownership of patents claiming the same broad language could exist. The claims of later filed applications would infringe the claims of the instant application.

Applicant's comments regarding different inventive entities noted; however, it should be noted that the instant application has at least one common inventor and has common ownership with the later filed applications and therefore, is a proper double patenting rejection. See the charts in early part of section 804.

Applicant's comments regarding dominance do not apply because the presence of domination does not preclude double patenting; but in any event the double patenting rejections were not made under *In re Schneller*. This is not an *In re Schneller* type situation, the broad claims of the instant application do not read on the more narrower claims of the later filed applications.

Applicant's comments regarding two-way obviousness also do not apply. Although, it is true that applicant could not have filed the claims in later filed applications in the instant application there are two requirements for two-way obviousness. In this case, there is no administrative delay. The office did not prevent the earlier filed application from issuing nor did the office prevent the earlier application from being prosecuted. It should be noted that normal prosecution of an application does not constitute delaying. Therefore, only a one-way test is required.

Applicant's contends that the claims in co-pending application 10/052,273 recite structures for urging the blade away from the cutting area instead of stopping the motion

Art Unit: 3724

of the cutting tool in to the cutting area. The examiner respectfully disagrees. Although the two applications do have different focuses, the fact that '273 reads on the instant claims is not diminished. A blade, which is urged away from the cutting area is clearly prevented from moving toward the cutting area and therefore, the motion toward the cutting area, by the blade is stopped.

Applicant contends that the rejection using Gains, Lokey, and Friemann is improper because the brakes of Gains function differently and could not function correctly. Applicant further contends that the examiner is ignoring the fact that there must a reasonable expectation that the suggested combination will succeed. However, it should be noted that there is no requirement for the teachings of Gains, Lokey and Friemann to be bodily incorporated. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

Applicant contends that there is no common ground between the unsafe conditions; however, the examiner respectfully disagrees. One of ordinary skill in the art would readily recognized that stopping a blade from moving into a cutting area of where a user's hand would be upon contact would in fact prevent further damage to the user's hand.

For the reasons above, the grounds of rejection are deemed proper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 571-272-4502. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'B. Ashley', is positioned above the printed name of the examiner.

Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
December 12, 2004